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United States Patent and Trademark Office (USPTO)

U.S. Application Serial No. 87614019

Mark: SPARK THERAPEUTICS GENERATION

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Reference/Docket No. N/A

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EXAMINING ATTORNEY'S APPEAL BRIEF

Applicant, Spark Therapeutics, Inc., appeals the trademark examining attorney's final refusal to register the applied-for mark SPARK THERAPEUTICS GENERATION PATIENT SERVICE in standard characters based on likelihood of confusion with U.S. Registration No. 4126694 for the mark SPARQ with a stylized design under Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d)¹.

¹ Please note that applicant also submitted an appeal of the refusal in its co-pending application, Application Serial No. 87614036, for the mark SPARK THERAPEUTICS GENERATION PATIENT SERVICES with stylized design.

I. FACTS

On September 19, 2017, applicant submitted an intent-to-use application under Section 1(b) of the Trademark Act for the mark SPARK THERAPEUTICS GENERATION PATIENT SERVICES in standard character form for use in connection with the following services (*as amended*): Providing information for patients, families and health care providers about health care insurance coverage, insurance reimbursement programs, insurance payer policies and patient financial assistance programs; claims and billing processing services involving processing and obtaining approval from insurance companies and government agencies for the payment of gene therapies, International Class 36; Providing health care information in connection with patient and family support programs, International Class 44; Patient and family health care coordination services for use in case management, namely, providing health care advisory and management services for coordinating educational, medical, social, and claims processing services for patients and their families relating to the treatment of gene-based diseases; providing patient advocate services for patients and their families regarding the coordination of medical services and related travel for patients and their families relating to the treatment of gene-based diseases; health care case management advice and consultation services, namely, care coordination for patients and families and coordinating medical, physical, personal care, and claims processing and services for patients and their families in dealing with medical service providers, hospitals, insurance companies, and others involved in patient care, International Class 45.

The examining attorney issued an office action on January 8, 2018 refusing registration based on Section 2(d) of the Trademark Act for a likelihood of confusion with the word and design mark SPARQ in U.S. Reg. No. 4126694 for use with in connection with "Providing health information services, namely, providing information relating to medical healthcare plans" in International Class 44. In addition, the applicant was informed of potentially confusing earlier-filed marks, was required to submit a disclaimer of descriptive wording, amend the identification of services and comply with multiple-class application

requirements. Applicant responded to that Office action on July 9, 2018 by submitting arguments against the Trademark Act Section 2(d) refusal, providing a disclaimer of the descriptive wording and amending the identification of services. On August 7, 2018, the applicant was suspending pending the disposition of the earlier-filed pending applications and the Trademark Act Section 2(d) refusal was maintained. On November 19, 2019, after the earlier-filed pending applications were abandoned, the examining attorney issued a final refusal of registration based on Section 2(d) of the Trademark Act for a likelihood of confusion with the aforementioned registered mark and the requirement for an acceptable identification of services was maintained and made final.

Subsequently, on May 19, 2019, applicant filed this appeal and contemporaneously filed a request for reconsideration containing arguments against the Trademark Act Section 2(d) refusal and amended the identification of the services. That request for reconsideration was denied by the examining attorney in a June 19, 2020 denial of the Request for Reconsideration letter with respect to the Section 2(d) refusal and the amended identification of services was acceptable. Applicant proceeded with the appeal by filing its August 18, 2020 appeal brief.

II. ISSUE

The issue on appeal is whether the applied-for mark SPARK THERAPEUTICS GENERATION PATIENT SERVICES in standard character form with "THERAPEUTICS" AND "PATIENT SERVICES" disclaimed for use in connection with "Providing information for patients, families and health care providers about health care insurance coverage, insurance reimbursement programs, insurance payer policies and patient financial assistance programs; claims and billing processing services involving processing and obtaining approval from insurance companies and government agencies for the payment of gene therapies, International Class 36; Providing health care information in connection with patient and family support programs, International Class 44; Patient and family health care coordination services for use in case management, namely, providing health care

advisory and management services for coordinating educational, medical, social, and claims processing services for patients and their families relating to the treatment of gene-based diseases; providing patient advocate services for patients and their families regarding the coordination of medical services and related travel for patients and their families relating to the treatment of gene-based diseases; health care case management advice and consultation services, namely, care coordination for patients and families and coordinating medical, physical, personal care, and claims processing and services for patients and their families in dealing with medical service providers, hospitals, insurance companies, and others involved in patient care, International Class 45,” is likely to cause confusion, to cause mistake, or to deceive under Section 2(d) of the Trademark Act with the registered mark SPARQ with a stylized design for use with in connection with “Providing health information services, namely, providing information relating to medical healthcare plans,” in International Class 44.

III. OBJECTION

The examining attorney maintains its objection to evidence that is not properly made of record. Specifically, applicant submitted a listing of third-party registrations in its Request for Reconsideration submitted on May 19, 2020 identified as Exhibits A and B. The examining attorney advised the applicant in the denial of the Request for Reconsideration on June 19, 2020 that the applicant’s mere submission of third-party registration submitted as Exhibits A and B does not make such registrations part of the record. Therefore, the examining attorney objects to the applicant’s references to these third-party registrations in its appeal brief. See Applicant’s Appeal Brief p. 12. The record in an application should be complete prior to the filing of an appeal. 37 C.F.R. §2.142(d); TBMP §§1203.02(e), 1207.01; TMEP §710.01(c). Because this evidence was not properly made of record prior to appeal, the trademark examining attorney objects to this evidence and requests that the Board disregard it. See *In re Inn at St. John’s, LLC*, 126

USPQ2d 1742, 1744 (TTAB 2018); *In re Fiat Grp. Mktg. & Corp. Commc'ns S.p.A.*, 109 USPQ2d 1593, 1596 (TTAB 2014); TBMP §§1203.02(e), 1207.01; TMEP §710.01(c).

IV. ARGUMENT

THE MARKS OF THE APPLICANT AND REGISTRANT ARE CONFUSINGLY SIMILAR IN APPEARANCE AND COMMERCIAL IMPRESSION AND THE SERVICES ARE CLOSELY RELATED SUCH THAT THERE EXISTS A LIKELIHOOD OF CONFUSION, MISTAKE OR DECEPTION UNDER SECTION 2(d) OF THE TRADEMARK ACT.

Trademark Act Section 2(d) bars registration of an applied-for mark that is so similar to a registered mark that it is likely consumers would be confused, mistaken, or deceived as to the commercial source of the goods and/or services of the parties. See 15 U.S.C. §1052(d). Likelihood of confusion is determined on a case-by-case basis by applying the factors set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973) (called the “*du Pont* factors”). *In re i.am.symbolic, llc*, 866 F.3d 1315, 1322, 123 USPQ2d 1744, 1747 (Fed. Cir. 2017). Any evidence of record related to those factors need be considered; however, “not all of the *DuPont* factors are relevant or of similar weight in every case.” *In re Guild Mortg. Co.*, 912 F.3d 1376, 1379, 129 USPQ2d 1160, 1162 (Fed. Cir. 2019) (quoting *In re Dixie Rests., Inc.*, 105 F.3d 1405, 1406, 41 USPQ2d 1531, 1533 (Fed. Cir. 1997)). Although not all *du Pont* factors may be relevant, there are generally two key considerations in any likelihood of confusion analysis: (1) the similarities between the compared marks and (2) the relatedness of the compared goods and/or services. See *In re i.am.symbolic, llc*, 866 F.3d at 1322, 123 USPQ2d at 1747 (quoting *Herbko Int'l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 1164-65, 64 USPQ2d 1375, 1380 (Fed. Cir. 2002)); *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 1103, 192 USPQ 24, 29 (C.C.P.A. 1976) (“The fundamental inquiry mandated by [Section] 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods [or services] and differences in the marks.”); TMEP §1207.01.

A. The marks share phonetic equivalent the term SPARK/SPARQ and are highly similar in overall commercial impression.

In the present case, applicant has applied for the mark SPARK THERAPEUTICS GENERATION PATIENT SERVICES in standard character form. Registrant's mark is SPARQ with a stylized design (shooting sun burst design above the wording). The applicant argues that the marks are "dissimilar in appearance, sound, connotation and commercial impression." See Applicant's Appeal Brief p. 9. When comparing marks, "[t]he proper test is not a side-by-side comparison of the marks, but instead whether the marks are sufficiently similar in terms of their commercial impression such that [consumers] who encounter the marks would be likely to assume a connection between the parties." *Cai v. Diamond Hong, Inc.*, 901 F.3d 1367, 1373, 127 USPQ2d 1797, 1801 (Fed. Cir. 2018) (quoting *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1368, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012)); TMEP §1207.01(b). The proper focus is on the recollection of the average purchaser, who retains a general rather than specific impression of trademarks. *In re Inn at St. John's, LLC*, 126 USPQ2d 1742, 1746 (TTAB 2018) (citing *In re St. Helena Hosp.*, 774 F.3d 747, 750-51, 113 USPQ2d 1082, 1085 (Fed. Cir. 2014); *Geigy Chem. Corp. v. Atlas Chem. Indus., Inc.*, 438 F.2d 1005, 1007, 169 USPQ 39, 40 (C.C.P.A. 1971)), *aff'd per curiam*, 777 F. App'x 516, 2019 BL 343921 (Fed. Cir. 2019); TMEP §1207.01(b).

Furthermore, marks must be compared in their entireties and should not be dissected; however, a trademark examining attorney may weigh the individual components of a mark to determine its overall commercial impression. *In re Detroit Athletic Co.*, 903 F.3d 1297, 1305, 128 USPQ2d 1047, 1050 (Fed. Cir. 2018) ("[Regarding the issue of confusion,] there is nothing improper in stating that . . . more or less weight has been given to a particular feature of a mark, provided the ultimate conclusion rests on consideration of the marks in their entireties." (quoting *In re Nat'l Data Corp.*, 753 F.2d 1056, 1058, 224 USPQ 749, 751 (Fed. Cir. 1985)). Marks may be confusingly similar in appearance where similar terms or phrases or similar parts of terms or phrases appear in the compared marks and create a similar overall commercial impression. See *Crocker Nat'l Bank v. Canadian Imperial Bank of Commerce*, 228 USPQ 689, 690-91 (TTAB 1986), *aff'd sub nom. Canadian Imperial Bank of Commerce v. Wells Fargo Bank, Nat'l Ass'n*, 811 F.2d

1490, 1495, 1 USPQ2d 1813, 1817 (Fed. Cir. 1987); *In re Corning Glass Works*, 229 USPQ 65, 66 (TTAB 1985); *In re Pellerin Milnor Corp.*, 221 USPQ 558, 560 (TTAB 1983) (finding MILTRON and MILLTRONICS confusingly similar); TMEP §1207.01(b)(ii)-(iii).

In this case, the marks share the identical phonetic equivalent first term SPAR[KQ]. The additional wording in the applicant's mark does not obviate the similarity between the marks. Although marks are compared in their entireties, one feature of a mark may be more significant or dominant in creating a commercial impression. See *In re Viterra Inc.*, 671 F.3d 1358, 1362, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012); *In re Nat'l Data Corp.*, 753 F.2d 1056, 1058, 224 USPQ 749, 751 (Fed. Cir. 1985); TMEP §1207.01(b)(viii), (c)(ii). Disclaimed matter that is descriptive of or generic for a party's goods and/or services is typically less significant or less dominant when comparing marks. *In re Detroit Athletic Co.*, 903 F.3d 1297, 1305, 128 USPQ2d 1047, 1050 (Fed. Cir. 2018) (citing *In re Dixie Rests., Inc.*, 105 F.3d 1405, 1407, 41 USPQ2d 1531, 1533-34 (Fed. Cir. 1997)); TMEP §1207.01(b)(viii), (c)(ii). Therefore, the additional disclaimed wording "THERAPEUTICS" and "PATIENT SERVICES" is not dispositive on the issue of similarity between the marks.

In addition, consumers are generally more inclined to focus on the first word, prefix, or syllable in any trademark or service mark. See *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 1372, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005); *Century 21 Real Estate Corp. v. Century Life of Am.*, 970 F.2d 874, 876, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992); see also *In re Detroit Athletic Co.*, 903 F.3d 1297, 1303, 128 USPQ2d 1047, 1049 (Fed. Cir. 2018). The applicant's and registrant's mark feature the first term phonetic equivalent wording, SPAR[KQ] which creates an overall similarity between the marks. The applicant has wholly appropriated the registrant's literal element in its mark and it is well settled that incorporating the entirety of one mark within another does not obviate the similarity between the compared marks, as in the present case, nor does it overcome a likelihood of confusion under Section 2(d). See *Wella Corp. v. Cal. Concept Corp.*, 558 F.2d 1019, 1022, 194 USPQ 419, 422 (C.C.P.A. 1977); *Coca-*

Cola Bottling Co. v. Jos. E. Seagram & Sons, Inc., 526 F.2d 556, 557, 188 USPQ 105, 106 (C.C.P.A. 1975); *In re Integrated Embedded*, 120 USPQ2d 1504, 1513 (TTAB 2016); *In re Mr. Recipe, LLC*, 118 USPQ2d 1084, 1090 (TTAB 2016); TMEP §1207.01(b)(iii).

The dominant literal word portions of the marks are similar in commercial impression; therefore, the addition of a design element does not obviate the similarity of the marks in this case. See *In re Shell Oil Co.*, 992 F.2d 1204, 1206, 26 USPQ2d 1687, 1688 (Fed. Cir. 1993); TMEP §1207.01(c)(ii). Accordingly, the examining attorney submits that the phonetic equivalent wording SPAR[KQ] is the dominant element in applicant's and registrant's marks and should be accorded more weight in finding that the marks create a similar overall commercial impression in the likelihood of confusion analysis.

B. The services are closely related, and found in the same trade channels.

The services are compared to determine whether they are similar, commercially related, or travel in the same trade channels. See *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1369-71, 101 USPQ2d 1713, 1722-23 (Fed. Cir. 2012); *Herbko Int'l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 1165, 64 USPQ2d 1375, 1381 (Fed. Cir. 2002); TMEP §§1207.01, 1207.01(a)(vi). The applicant's attempt to restrict the registrant's services as "directed to hospital administration and specific policy offerings akin to 'over the county' information related to third-party insurance offerings," is not persuasive. See Applicant's Appeal Brief p. 10. Determining likelihood of confusion is based on the description of the services stated in the application and registration at issue, not on extrinsic evidence of actual use. See *In re Detroit Athletic Co.*, 903 F.3d 1297, 1307, 128 USPQ2d 1047, 1052 (Fed. Cir. 2018) (citing *In re i.am.symbolic, llc*, 866 F.3d 1315, 1325, 123 USPQ2d 1744, 1749 (Fed. Cir. 2017)). In this case, the applicant's and registrant's healthcare services, including healthcare information services of the parties have no restrictions as to nature, type, channels of trade, or classes of purchasers and are "presumed to travel in the same channels of trade to the same class of purchasers." *In re Viterra Inc.*, 671 F.3d 1358, 1362, 101 USPQ2d 1905, 1908

(Fed. Cir. 2012) (quoting *Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 1268, 62 USPQ2d 1001, 1005 (Fed. Cir. 2002)).

The previously attached Internet evidence from *Catalyst*, *Patientcare*, *Healthalliance*, *BCBSIL*, *PatientSupportServicesUSA* and *Sanofigenzyme* included submitted extensive third-party website evidence submitted in the Office Action of November 19, 2019 establishes that it is common for a single entity to provide both healthcare information services and patient care services featuring case management services and information services on medical health care plans under the same mark. Evidence obtained from the Internet may be used to support a determination under Section 2(d) that services are related. See, e.g., *In re G.B.I. Tile & Stone, Inc.*, 92 USPQ2d 1366, 1371 (TTAB 2009); *In re Paper Doll Promotions, Inc.*, 84 USPQ2d 1660, 1668 (TTAB 2007). The below-listed representative samplings of evidence of record shows that that the applicant's and registrant's services consisting of healthcare information services and patient care services featuring case management services and information services on medical health care plans are marketed within the same channels of trade:

- <https://catalyst.nejm.org/what-is-care-coordination/>; November 19, 2019, Office Action, TSDR pp. 2-13 (Third-party website that discusses health care coordination services inclusive of a variety of healthcare information)
- <https://www.patientcare.va.gov/>; November 19, 2019, Office Action, TSDR pp. 14-16 (Third-party website showing healthcare services provided under the umbrella of patient care services including case management services and health information services)
- <https://www.healthalliance.org/health-and-wellness/care-coordination>; November 19, 2019, Office Action, TSDR pp. 17-19 (Third-party website showing that Health Alliance provides care coordination services including that provides healthcare information services, disease management and healthcare coaching)
- <https://www.bcbsil.com/bcchp/getting-care/care-coordination.html>; November 19, 2019, Office Action, TSDR pp. 20-21 (Third-party website that provides information on care coordination services including healthcare information services on health conditions, medications and treatment options)

- <https://www.patientsupportservicesusa.com/services>; November 19, 2019, Office Action, TSDR pp. 22-25 (Third-party website showing that Patient Support Services USA, LLC provides case management services for Medicare insurance providers for healthcare providers including healthcare plan information services about costs of care)
- <https://www.sanofigenzyme.com/en/patient-support/patient-services>; November 19, 2019, Office Action, TSDR pp. 26-32 (Third-party website showing that Sanofi Genzyme provides patient care services including assistance and information on insurance plans, treatment options and educational resources on disease and treatment management)

The applicant's assertion that there is no likelihood of confusion because "the services provided by Applicant are highly customized and personal relating to gene therapy treatment undertaken ...with a great deal of consideration," is not dispositive in this case. See Applicant's Appeal Brief p. 11. The fact that purchasers are sophisticated or knowledgeable in a particular field does not necessarily mean that they are sophisticated or knowledgeable in the field of trademarks or immune from source confusion. TMEP §1207.01(d)(vii); see, e.g., *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d. 1317, 1325, 110 USPQ2d 1157, 1163-64 (Fed. Cir. 2014); *Top Tobacco LP v. N. Atl. Operating Co.*, 101 USPQ2d 1163, 1170 (TTAB 2011). Further, where the purchasers consist of both professionals and the public, the standard of care for purchasing the goods [services] is that of the least sophisticated potential purchaser. *In re FCA US LLC*, 126 USPQ2d 1214, 1222 (TTAB 2018) (citing *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d. at 1325, 110 USPQ2d at 1163). As evidenced in the article in *Investors.com* both the applicant and registrant offer services relating to gene therapy treatment. See June 19, 2020, Office Action, TSDR pp. 2-6. Moreover, the applicant's arguments regarding the trade channels of applicant and registrant appear to impose limitations on the respective identifications which are not present in the application or registration. Applicant has provided no evidence to support that the identified services occupy distinct trade channels. The presumption under Trademark Act Section 7(b) is that the registrant is the owner of the mark and that their use of the mark extends to all services identified in the registration. 15 U.S.C. §1057(b). In the absence of limitations as to channels of trade or classes of purchasers in the

services in the registration, the presumption is that the services move in all trade channels normal for such and are available to all potential classes of ordinary consumers of such services. See *In re I-Coat Co.*, 126 USPQ2d 1730, 1737 (TTAB 2018); *In re Melville Corp.*, 18 USPQ2d 1386, 1388 (TTAB 1991); TMEP §1207.01(a)(iii).

Additionally, the fact that the applicant owns Registration No. 5068997 for the standard character mark SPARK for use in connection with “biologic preparations for use in the diagnosis and treatment of retinal degenerative and hematologic disorders and diseases” is not dispositive on the likelihood of confusion analysis. In *In re Strategic Partners, Inc.*, 102 USPQ2d 1397, 1399-1400 (TTAB 2012), the Trademark Trial and Appeal Board only reversed a Section 2(d) refusal based on an applicant’s prior registration for the following unique set of facts: (1) the marks in applicant’s prior registration and application were virtually identical (“no meaningful difference” existed between them, such that they were “substantially similar”); (2) the goods were identical in part; and (3) the prior registration had co-existed for at least five years with the cited registration (both being more than five years old and thus immune from attack on likelihood of confusion grounds). See TMEP §1207.01. The Board acknowledged these facts constituted a “unique situation,” such that an applicant’s prior registration would generally need to fit within these precise parameters to overcome a Section 2(d) refusal. *In re Strategic Partners, Inc.*, 102 USPQ2d at 1400; see *In re USA Warriors Ice Hockey Program, Inc.*, 122 USPQ2d 1790, 1793-94 (TTAB 2017); TMEP §1207.01. In this case, by contrast, applicant’s prior registration does not correspond to the facts set forth in *In re Strategic Partners, Inc.* See TMEP §1207.01. Specifically, applicant’s prior registration is not for the same mark or services. Thus applicant’s prior registration does not obviate the Section 2(d) refusal.

V. CONCLUSION

Applicant’s mark, SPARK THERAPEUTICS GENERATION PATIENT SERVICES in standard character, is highly similar to registrant’s mark, SPARQ with a stylized design, and applicant’s services are closely

related to registrant's services. The evidence shows that the marks are similar in appearance, sound, connotation, and commercial impression and that the services of applicant and registrant are commonly offered by the same source and under the same mark. Accordingly, consumers are likely to be confused as to the source of the services. The overriding concern is not only to prevent buyer confusion as to the source of the services, but to protect the registrant from adverse commercial impact due to use of a similar mark by a newcomer. See *In re Shell Oil Co.*, 992 F.2d 1204, 1208, 26 USPQ2d 1687, 1690 (Fed. Cir. 1993). Therefore, any doubt regarding a likelihood of confusion determination is resolved in favor of the registrant. TMEP §1207.01(d)(i); see *Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 1265, 62 USPQ2d 1001, 1003 (Fed. Cir. 2002); *In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 463, 464-65, 6 USPQ2d 1025, 1026 (Fed. Cir. 1988). The examining attorney respectfully requests that the Board affirm the refusal to register applicant's mark under Trademark Act Section 2(d).

Respectfully submitted,

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